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JOSEPH PHILLIP BIGUS

IBM/02B

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26517 7590 09/02/2010  
WOOD, HERRON & EVANS, L.L.P. (IBM)  
2700 CAREW TOWER  
441 VINE STREET  
CINCINNATI, OH 45202

EXAMINER

COPPOLA, JACOB C

ART UNIT

PAPER NUMBER

3621

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/431,833 | <b>Applicant(s)</b><br>BIGUS ET AL. |  |
|                              | <b>Examiner</b><br>JACOB C. COPPOLA  | <b>Art Unit</b><br>3621             |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 54,56,57,59-61,104,105,107,109,110 and 112-116 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 54, 56, 57, 59-61, 104, 105, 107, 109, 110, and 112-116 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

1. This Office Action is in reply to Applicants' response filed on 30 June 2010 ("2010 June Response").
2. Claims 54, 56, 57, 59-61, 104, 105, 107, 109, 110, and 112-116 are currently pending and have been examined.
3. This Office Action is given Paper No. 20100830. This Paper No. is for reference purposes only.

### ***Claim Rejections - 35 USC §112, Second Paragraph***

4. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 54, 56, 57, 59-61, 104, 105, 107, 109, 110, and 112-116 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claim 54 recites:

- 1 A method of identifying an unknown party interacting with an intelligent agent,
- 2 the method comprising, in a computer that includes at least one processor, executing a
- 3 program to perform the steps of:
- 4 determining a plurality of attributes related to the unknown party, wherein
- 5 the unknown party is a party other than a client that has delegated at least one task
- 6 to the intelligent agent;

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7           comparing the plurality of attributes for the unknown party with attributes related  
8 a plurality of known parties; and  
9           identifying the unknown party as the known party having attributes that most  
10 closely match those of the unknown party;  
11           wherein the unknown party is an intelligent agent configured to conduct electronic  
12 transactions, and wherein the plurality of attributes is selected from the group consisting  
13 of an agent name, a client name, a bank name, a bank account number, a credit card number,  
14 a homebase location, an agent program name, a location or name of a source with which  
15 the unknown party communicates, and combinations thereof.

Regarding Claims 54, 56, 57, 59-61, 104, 105, 107, 109, 110, and 112-116

6.       Claim 54 recites "... the known party having the attribute which most closely matches that of the unknown party..." See ll. 9-10. Claim 54 is indefinite because the phrase "most closely matches" as used in the context of claim 54 is subjective and lacks a definitive meaning. One of ordinary skill in the art would not be able to distinguish between attributes that match and those that "most closely match[].".

7.       Claims 60, 61, 113, and 114 recite similar limitations and are rejected for the same reasoning as directly above.

8.       Claim 54 is indefinite because the scope of the claimed "intelligent agent" cannot be determined. It is unclear how much intelligence an agent must possess to be considered "intelligent." In discussing the importance of a computer program such as an "intelligent agent," Applicants elude to the existence of other types of computer programs. See 09 Feb Response at p. 9. It is unclear whether these other types of programs either 'are' or 'are not' within the scope of claim 54. In other words, are these other programs non-intelligent agents, less intelligent

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agents, more intelligent agents, etc.? Guidance on intelligence is provided by Applicants on p. 3 of the specification:

Intelligent agents may also have differing capabilities in terms of intelligence, mobility, agency, and user interface. Intelligence is generally the amount of reasoning and decision making that an agent possesses. This intelligence can be as simple as following a predefined set of rules, or as complex as learning and adapting based upon a user's objectives and the agent's available resources.

9. From this section of the specification, one of ordinary skill in the art would understand that the intelligent agent varies in intelligence. Nevertheless, from the surrounding text of the claims, it is unclear whether the claimed “intelligent agent” is in possession of a certain amount of reasoning and decision making that makes it *intelligent*. The claim is ambiguous as to where the line is drawn in which an agent is determined to be non-intelligent vs. intelligent.

10. Claims 60, 61, 113, and 114 recite similar limitations and are rejected for the same reasoning as directly above.

11. Claim 54 recites:

wherein the plurality of attributes is selected from the group consisting of an agent name, a client name, a bank name, a bank account number, a credit card number, a homebase location, an agent program name, a location or name of a source with which the unknown party communicates, and combinations thereof.

See ll. 11-15.

12. First, claim 54 is indefinite because the meaning of the “group consisting of” is unclear in view of Applicants’ remarks. The Federal Circuit has determined that the phrase “group consisting of” is a closed term. See MPEP §2111.03. However, Applicants argue “It should also be noted that *given that the claims are open-ended, additional attributes beyond those*

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enumerated in the claims could also be compared in connection with identifying an unknown party.” See 09 Feb Response at p. 9.

13. Second, claim 54 requires the group to consist of several attributes and combinations thereof. However, the transitional phrase “consisting of” defines the scope of a claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim. See MPEP §2111.03. Accordingly the scope of claim 54 is defined to exclude all attributes unrecited in the list “an agent name, a client name, a bank name, a bank account number, a credit card number, a homebase location, an agent program name, a location or name of a source with which the unknown party communicates, and combinations thereof.” But the claim does allow for other scope definitions excluding attributes unrecited in “combinations thereof,” which will be subsets of the entire list. When the group is interpreted to be one of a “combinations thereof” (a subset of the listed attributes), then the scope of claim 54 is not defined to exclude all attributes unrecited in the list, rather it is now defined to exclude only the attributes of the subset combination. Therefore, claim 54 is indefinite because of the conflicting definitions of scope.

14. Claims 60, 61, 113, and 114 recite similar limitations and are rejected for the same reasoning as directly above.

15. Claim 60 recites “a database including a plurality of records, each record associated with a known party and including the plurality of attributes related thereto....” Claim 60 is indefinite because it is unclear if each record has “attributes related thereto” or if only the plurality of records as a whole has “attributes related thereto.”

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16. The Examiner finds that because particular claims are rejected as being indefinite under 35 U.S.C. §112, second paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though the claims are indefinite, the claims are construed and the art is applied *as much as practically possible*.

#### ***Claim Rejections - 35 USC §102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

18. Claims 54, 56, 57, 59-61, 104, 105, 107, 109, 110, and 112-116, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by Stefik (U.S. 5,715,403 A).

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Regarding Claims 54, 56, 57, 59-61, 104, 105, 107, 109, 110, and 112-116

19. Stefik discloses:

determining a plurality of attributes (*e.g.*, “**1516~Access-Spec**”: fig. 15, determining shown in fig. 1) related to an unknown party (“Repository 2”: fig. 1), wherein the unknown party is a party other than a client that has delegated at least one task to the intelligent agent (no delegation involved between repositories);

comparing the plurality of attributes for the unknown party with attributes related to a plurality of known parties (repository 1 must know attributes of all authorized repositories – they will be listed in the rights for the digital work – fig. 15, also attribute 1516 relates to plurality of possible repositories); and

identifying the unknown party as the known party having the attributes which most closely match those of the unknown party (if “id” of repository 2 found in list of authorized repositories matches, repository 2 can have digital work, “access granted” – fig. 1);

wherein the unknown party is an intelligent agent (repositories are intelligent – see fig. 12) configured to conduct electronic transactions (see “credit server”), and wherein the plurality of attributes is selected from the group consisting of an agent name (1516 can be a name, see also c. 27), a client name, a bank name, a bank account number, a credit card number, a homebase location, an agent program name, a location or name of a source with which the unknown party communicates, and combinations thereof.



***Claim Interpretation***

20. The Examiner has again determined that claims 60, 61, 104, 105, 107, 109, 110, and 112-116 are not patentably distinct from claims 54, 56, 57, and 59 (*i.e.*, claims 60, 61, 104, 105, 107, 109, 110, and 112-116 are of substantially the same subject matter as claims 54, 56, 57, and 59). Accordingly, claims 60, 61, 104, 105, 107, 109, 110, and 112-116 are rejected in substantially the same manner as claims 54, 56, 57, and 59.

***Response to Arguments***

35 U.S.C. §112, Second Paragraph

21. Applicants argue:

Third, in paragraphs 17-18, the Examiner objects to the term “most closely matches,” arguing that the language is subjective and therefore indefinite. Applicant respectfully traverses this rejection, as Applicant submits that this term, when read in the context of the specification, is definite.

See 2010 June Response at p. 9 of 18.

22. This argument is not persuasive. It is improper to import claim limitations from the specification. Claims and their terms, minus lexicography and 112, sixth paragraph, are not to be “read in the context of the specification.” See MPEP § 2111.01 II.

23. Applicants further argue “Applicant is aware of no blanket prohibition against subjective terms.” See 2010 June Response at p. 10 of 18. The Examiner respectfully directs Applicants to 35 U.S.C. §112, second paragraph.

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24. Applicants argue:

Applicant respectfully submits that based upon the definition in the specification and the well known meaning of the term, what is and what isn't an "intelligent agent" would be readily apparent to one of ordinary skill in the art.

See 2010 June Response at p. 10 of 18.

25. The Examiner respectfully disagrees. As noted in the previous Office Action mailed on 30 March 2010 at p. 11, the Examiner is unable to locate any lexicographic definitions with the required clarity, deliberateness, and precision. See MPEP §2111.01 IV. This includes a definition of "intelligent agent." Applicants have not traversed this finding in their 2010 June Response. Therefore, Applicants' arguments are not persuasive since a definition of intelligent agent is not found.

26. Applicants argue:

Fifth, in paragraphs 23-27, the Examiner objects to the language "selected from the group consisting of .... and combinations thereof." This language, however, is nothing more than a standard recitation of a Markush group. *See, e.g.*, MPEP 2173.05(h) and Ex parte Markush (1925 CD 126 (Comm'r Pat. 1925)).

See 2010 June Response at p. 10 of 18 (emphasis in original).

27. The Examiner respectfully disagrees. There is no discussion of Markush groups using the language of "and combinations thereof" in the cited MPEP section. Therefore, the Examiner concludes that Applicants' claims are not "nothing more than a standard recitation of a Markush group." Moreover, Applicants have not addressed the merits of the Examiner's rejection regarding MPEP §2111.03. The rejection is maintained.

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Prior Art

28. Applicants argue:

Applicant hereby states on the record that the claims are patentably distinct from one another, with the evidence therefor being the differing language in the respective claims.

See 2010 June Response at p. 12 of 18.

29. The Examiner finds that assertion of “differing language in the respective claims” is insufficient evidence to show that claims are patentably distinct. Because the evidence is insufficient, the argument is not persuasive.

30. For example, see MPEP §804 for discussion on nonstatutory type double patenting. If differing language *per se* between any two claims automatically resulted in patentable distinctness between these two claims, then no two claims would ever be rejected under nonstatutory type double patenting. For this reason alone, Applicants’ argument is not persuasive and the Examiner maintains the position that the claims are not patentably distinct.

31. The Examiner finds that because particular claims are rejected as being indefinite under 35 U.S.C. §112, second paragraph, it is impossible to properly construe claim scope at this time. Because the claims cannot be properly construed, it is impossible to properly evaluate the veracity of Applicants’ arguments and assertions attempting to distinguish the claims from the prior art, as found on pp. 13-18 of the 2010 June Response. For example, Applicants’ argue “Stefik is entirely silent with regard to intelligent agents.” The veracity of this argument cannot be determined because the scope of “intelligent agent” is unclear (see 112, 2<sup>nd</sup> ¶ rejection above).

***Conclusion***

32. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

33. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112, first paragraph written description and enablement, §112, second paragraph indefiniteness, and §102 and §103, prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

34. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R.

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§ 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

35. Applicants are respectfully reminded that any suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. To be especially clear, any suggestion or example provided in this Office Action (or in any future office action) does *not* constitute a formal requirement mandated by the Examiner.

a. Should Applicants decide to amend the claims, Applicants are also reminded that—like always—no new matter is allowed. The Examiner therefore leaves it up to Applicants to choose the precise claim language of the amendment in order to ensure that the amended language complies with 35 U.S.C. §112, first paragraph.

b. Independent of the requirements under 35 U.S.C. §112, first paragraph, Applicants are also respectfully reminded that when amending a particular claim, all claim terms must have clear support or antecedent basis in the specification. See 37 C.F.R. §1.75(d)(1) and MPEP §608.01(o). Should Applicants amend the claims such that the claim language no longer has clear support or antecedent basis in the specification, an objection to the specification may result. Therefore, in these situations where the amended claim language does *not* have clear support or antecedent basis in the specification and to prevent a subsequent ‘Objection to the Specification’ in the next office action, Applicants are encouraged to either (1) re-evaluate the amendment and change the claim language so the claims *do* have clear support or antecedent basis or, (2) amend the specification to ensure that the claim language does have clear support or

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antecedent basis. See again MPEP §608.01(o) (¶3). Should Applicants choose to amend the specification, Applicants are reminded that—like always—no new matter in the specification is allowed. See 35 U.S.C. §132(a). If Applicants have any questions on this matter, Applicants are encouraged to contact the Examiner via the telephone number listed below.

36. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

37. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/  
Patent Examiner, Art Unit 3621  
August 30, 2010

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621